

EXHIBIT B

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/006,953	6455275	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for ex parte reexamination filed 27 February 2004 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO-1449, c) Other _____

1. The request for ex parte reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

MAY 10 2004

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). NO EXTENSION OF THIS TIME PERIOD IS PERMITTED. If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for ex parte reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
- b) by credit to Deposit Account No. _____, or
- c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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DECISION

A substantial new question of patentability affecting claims 1-20 of United States Patent Number 6,455,275 is raised by the request for reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in reexamination proceedings are provided for in 37 CFR 1.550(c).

The request indicates that Requestor considers that Claims 1-20 are unpatentable for double patenting in view of US Patents 4,399,216 (hereafter the '216 patent), 4,634,665 (hereafter the '665 patent) and 5,179,017 (hereafter the '017 patent), all to Axel et al.

Specifically, Requestor indicates that claims 1-4 and 20 are unpatentable over Claims 47, 54, 70 and 73 of the '216 patent and over Claims 2, 4 and 5 of the '017 patent. The request indicates that Claims 5, 16 and 18 are unpatentable over Claim 12 of the '665 patent alone or in combination with claim 2 of the '017 patent. The request indicates that claim 6 is unpatentable over claims 11 and 12 of the '665 patent and over claim 2 of the '017 patent. The request indicates that claims 7-9 are unpatentable claims 3 and 12 of the '665 patent alone or in combination with claim 2 of the '017 patent. The request indicates that claims 10-12 are unpatentable over claims 2 and 12 of the '665 patent and over claim 2 of the '017 patent. The request indicates that claims

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13 and 19 are unpatentable over claim 12 of the '665 patent and over claims 2 and 5 of the '017 patent. The request indicates that claims 14 and 15 are unpatentable over claims 12 and 14 of the '665 patent and over claim 2 of the '017 patent. The request indicates that claim 17 is unpatentable over claim 12 of the '665 patent and over claims 2 and 4 of the '017 patent.

It is noted that double patenting rejections over claims in the '017 and '216 patents were made by the examiner in the prosecution of the application which matured into the '275 patent. A double patenting rejection over the '665 patent claims was not made in the prosecution of the application which matured into the '275 patent.

It is agreed that the consideration of the '216, '665 and '017 patents raises a substantial new question of patentability as to claims 1-20 of the 6,455,275 (hereafter the '275 patent). As pointed out on pages 8-26 of the request, the '216, '017 and '665 patents claim similar subject matter which varies in scope, differs in nomenclature and/or potentially inherently reads on the subject matter recited in claims 1-20 of the '275 patent.

With regard to Claims 5-19, the teachings as to the similar subject matter claimed in the '665 patent alone or the '665 patent in combination with claims in the '017 patent were not present in the prosecution of the application which became the '275 patent. Specifically, with regard to claims 5-19, the inherency of the amplification of the DNA II, the nature of the proteins expressed by the DNA II, the attachment of the DNA I and/or

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DNA II to a bacterial plasmid or phage DNA and the nature of the proteinaceous material (glycoproteins) expressed in the CHO cells are limitations similar to those recited in the claims of the '665 patent and the '665 patent in view of the claims in the '017 patent. Further there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. Accordingly, the '665 patent alone and/or considered with the '017 patent raises a substantial new question of patentability as to Claims 5-19.

The above substantial new question of patentability is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

"The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on US Patents 4,399,216 and 5,179,017 and/or 4,399,216 in view of 5,179,017. A discussion of the specifics now follows:

With regard to Claims 1-4 and 20, new arguments concerning whether the claims in the '017 and '216 patents render obvious the linking of the two DNA molecules (DNA I and DNA II) recited in claim 1, arguments concerning the lack of differences between claim 2 of the '275 patent and claim 5 of the '017 patent or claim 54 of the '216 patent, arguments

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concerning whether claim 3 is obvious in view of the amplified DNA recited in claim 47 of the '216 patent or claim 4 of the '017 patent and arguments concerning whether claim 4 is obvious in view of claim 4 of the '014 patent in view of claim 47 of the '216 patent require viewing the old art in a new light and raise a substantial new question of patentability.

David Guzo
Primary Examiner
Technology Center 1600


DAVID GUZO
PRIMARY EXAMINER

PTO/SB/08A (08-03)

Approved for use through 07/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Substitute for form 1449 PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Application Number	08/484,138
		Filing Date	June 7, 1995
		First Named Inventor	Axel
		Art Unit	1636
		Examiner Name	DAVID GUVZO
		Attorney Docket Number	

Examiner Signature		Date Considered	5/2/04
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹Applicant's unique citation designation number (optional). ²See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵Kind of document by the appropriate symbol as indicated on the document under WIPO Standard ST.16 if possible. ⁶Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by this USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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90/006,953	02/27/2004	6455275		7971
759B	05/06/2004		EXAMINER	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.